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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/911,053 | 07/23/2001 | Pradeep K. Bansal | 1999-0215 | 3729 |

7590 09/27/2004

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| EXAMINER |
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ZURITA, JAMES H

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,053

Applicant(s)

BANSAL ET AL.

Examiner

James H Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. ***Claims 1-16***, drawn to a system for entering data into a database, classified in class 707/3.
- II. ***Claims 17-45***, drawn to a system for selecting a shipper for merchandise, classified in class 705/26.
- III. ***Claims 46***, drawn to a system for receiving and accessing data, classified in class 379, subclass 142.01.
- IV. ***Claim 47*** drawn to a method for providing data access with a key, classified in class 709, subclass 217.
- V. ***Claim 48***, drawn to a method for entering data, classified in class 707/3.
- VI. ***Claims 49*** drawn to a system for remote data access with a key, classified in class 709, subclass 217.

Group I (including Inventions I-V) and Group II (invention VI) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because **Group II** requires the use of computers, while **Group I** can be performed manually. Because these inventions are distinct for these

reasons and the search required for **Group I** is not required for **Group II**, restriction for examination purposes as indicated is proper.

Within Group I (including Inventions I-V)

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention **II** does not require entering data. The subcombination has separate utility in that Invention **II** has a separate feature of selecting a shipper from a preselected list of shippers.

Because these inventions are distinct for the reasons given above and the search required for Invention **I** is not required for Invention **II**, restriction for examination purposes as indicated is proper.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention **III** does not require data entry into a database. The subcombination has separate utility in that Invention **III** has a

separate feature of registering a user, authenticating the identity of a user, sending the address to a user.

Because these inventions are distinct for the reasons given above and the search required for Invention *I* is not required for Invention *III*, restriction for examination purposes as indicated is proper.

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention *IV* does not require entering data. The subcombination has separate utility in that Invention *IV* has a separate feature of accessing data using a key.

Because these inventions are distinct for the reasons given above and the search required for Invention *I* is not required for Invention *IV*, restriction for examination purposes as indicated is proper.

Inventions I and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention *V* does not require

Art Unit: 3625

entering name of an address owner. The subcombination has separate utility in that Invention **V** has a separate feature of entering customer security level and customer ID.

Because these inventions are distinct for the reasons given above and the search required for Invention **I** is not required for Invention **V**, restriction for examination purposes as indicated is proper

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention **III** does not require selecting a shipper from a list of preselected shippers. The subcombination has separate utility in that Invention **III** has a separate feature of receiving registration information from an address owner.

Because these inventions are distinct for the reasons given above and the search required for Invention **II** is not required for Invention **III**, restriction for examination purposes as indicated is proper.

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §

Art Unit: 3625

806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention *IV* does not require selecting a shipper from a list of preselected shippers. The subcombination has separate utility in that Invention *IV* has a separate feature of requesting an access key.

Because these inventions are distinct for the reasons given above and the search required for Invention *II* is not required for Invention *IV*, restriction for examination purposes as indicated is proper.

Inventions II and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention *V* does not require selecting a shipper from a preselected shipper list. The subcombination has separate utility in that *Invention V* has a separate feature of entering data.

Because these inventions are distinct for the reasons given above and the search required for *Invention II* is not required for *Invention V*, restriction for examination purposes as indicated is proper.

Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and

Art Unit: 3625

(2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention **IV** does not require receiving registration information for an address owner. The subcombination has separate utility in that Invention **IV** has a separate feature of providing data access with a key.

Because these inventions are distinct for the reasons given above and the search required for Invention **III** is not required for Invention **IV**, restriction for examination purposes as indicated is proper.

Inventions III and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed *does not require* the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention **V** does not require authenticating the identity of a user. The subcombination has separate utility in that Invention **V** has a separate feature of entering data.

Because these inventions are distinct for the reasons given above and the search required for Invention **III** is not required for Invention **IV**, restriction for examination purposes as indicated is proper.

Inventions IV and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention ***V*** does not require sending a message and requesting an access key. The subcombination has separate utility in that Invention ***V*** has a separate feature of entering data.

Because these inventions are distinct for the reasons given above and the search required for Invention ***IV*** is not required for Invention ***V***, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

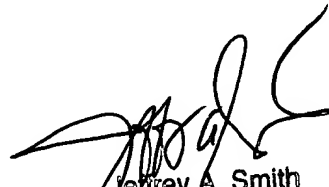
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
20 September 2004


Jeffrey A. Smith
Primary Examiner